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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,944	04/06/2001	Galo F. Acosta	2599-103-D1	6262
6449	7590	04/22/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			CROSS, LATOYA I	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,944

Applicant(s)

ACOSTA ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34, 36, 37, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 35 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on January 21, 2004. Claims 34-40 are pending.

#### *Withdrawal of Rejections from Previous Office Action*

- The rejection of claims 33-37 over Mack in view of Astle is withdrawn in view of Applicants' persuasive argument that neither Mack nor Astle teaches a substance transfer device that dispenses while simultaneously aspirating.

#### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,104,808 to Laska et al.

Laska et al disclose a method and system for performing a plurality of assays on a plurality of samples. The system comprises a substance transfer device comprising blocks 208 and 212. Block 208 comprises wash probes (dispensing devices) (182, 186 and 189. Block 212 comprises aspirate probes (184, 188, 190 and 192). When the leading vessel from the group of vessels is ready to be washed, then the wash probes enter the vessels simultaneously and the aspiration or dispensing occurs simultaneously (col. 14, lines 46-52).

Laska et al do not explicitly teach that the aspiration and dispensing occur simultaneously. However, at col. 24, lines 21-29, the reference teaches that "simultaneously sample and/or reagent are added to the vessels and mixed and the vessels are washed using the

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wash means. It would have been obvious to one of ordinary skill in the art that the dispensing into and aspirating out of the vessels can be performed simultaneously. Obviously, to have both process done at the same time would increase the throughput of the system, allowing the samples to be processed in a shorten amount of time.

Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Laska et al.

3. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laska as applied to claims 34, 39 and 40 above, and further in view of US patent 4,478,094 to Salomaa et al.

The disclosure of Laska et al is described above. Laska et al fail to teach a contamination limiting element.

Salomaa et al teach a liquid handling system having multiple contamination limiting elements (62). The contamination limiting elements are engageable by a substance transfer device (38). Salomaa et al teach that the contamination limiting elements help to maintain sterile conditions during the substance transfer process. See col. 1, line 57 – col. 2, line 14. it would have been obvious to one of ordinary skill in the art to incorporate contamination limiting elements into the substance transfer device of Laska et al to aid in maintaining a clean environment and to aid in the prevention of contamination.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Laska et al and Salomaa et al.

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*Allowable Subject Matter*

4. Claims 35 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest a handle structure mounted to the support of a substance transfer device, as claimed in claim 34, to allow manual manipulation of the substance transfer device.

*Response to Arguments*

5. Applicant's arguments with respect to claims 34-40 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256.


The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
Supervisory Patent Examiner  
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